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PATENT
Attorney Docket No. 56490.000002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Technology Center 2100

In re Patent Application of:

David VERCHERE

Serial Number: 09/441,204

Filed: November 16, 1999

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Group Art Unit: 2165

Examiner: Carlos A. Azpuru

For: METHOD AND SYSTEM FOR ACQUIRING BRANDED PROMOTIONAL
PRODUCTS

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO PAPER NO. 5

In the Office Action mailed February 28, 2001, Examiner Azpuru indicated that claims 1-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bemrose. In particular, Examiner Azpuru has indicated that Bemrose discloses a fully functional web site for purchasing imprinted promotional items.

35 U.S.C. § 102(b) states that “a person shall be entitled to a patent unless the invention was patented or described in a *printed publication* in this or a foreign country or in public use or on sale in this country, *more than one year prior to the date of application for patent* in the United States” (emphasis added).

A reference is proven to be a “printed publication” “upon a satisfactory showing that such document has been disseminated or otherwise made available to the extend that persons

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interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it. M.P.E.P. 2128. *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981)(quoting *I.C.E. Corp v. Armco Steel Corp.*, 250 F.Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)).

Examiner Azpuru has not established that the invention was described in a printed publication more than one year prior to the date of application for patent. The Bemrose article has a publication date of April 11, 2000, as indicated on the face of the article. In addition, the Examiner has cited the Bemrose reference in PTO-892 as having a date of April 2000. Applicant filed for an application for patent in the United States on November 16, 1999. Applicant's filing date is clearly before the publication date attributed to the Bemrose article. Therefore, the Bemrose article having a publication date of April 11, 2000 cannot be applied as a proper rejection, under 35 U.S.C. § 102(b).

The Bemrose article further contains a notice of copyright of 1994-2000 which is attributed to M2 Communications LTD, a British-based international publishing and media services company which also operates M2 PressWIRE, an electronic press release distributed service in operation since 1994. On March 6, 2001, in response to an inquiry from Applicant's representative, the Examiner orally indicated that while relying on the 1994-2000 copyright, the Examiner allegedly contacted the Bemrose company to confirm that the business method described in the article published on April 11, 2000 has been implemented since 1994. Examiner Azpuru's reliance on the copyright date is improper. M.P.E.P. 901.06 states that "all printed publications may be used as references, the date to be cited being the publication date". The date

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of publication is that date when the work is first received by any member of the public. *Carella v. Starlight Archery*, 804 F.2d 135, 139, USPQ 644, 647 (Fed. Cir. 1986); *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978). There is no support for relying on a copyright date when the publication date is available. In addition, the copyright date range of 1994-2000 is attributed to the publishing entity, and not to the subject matter disclosed by Bemrose in the article made available to the public on April 11, 2000.

For argument sake, even if Examiner's allegation of confirmation of Bemrose is acceptable, Examiner's alleged oral confirmation cannot be construed as public use under 35 U.S.C. § 102(b). As Bemrose is a company in the UK, Examiner Azpuru has not established that any public use occurred in this country one year before the filing date of Applicant's invention, as required by 35 U.S.C. § 102(b). In addition, Examiner Azpuru's verbal representation of personal knowledge is not enough to establish *public* use of the claimed invention since 1994. Further, mere knowledge of the invention by the public does not warrant rejection under 35 U.S.C. § 102(b). 35 U.S.C. § 102(b) bars public use or sale, not public knowledge. M.P.E.P. 2133.03(a).

37 C.F.R. 1.104(d)(2) states that when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the

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affidavits of the applicant and other persons. Therefore, any oral assertions of personal knowledge by the Examiner must be supported.

Examiner has failed to satisfy his burden of proof in presenting a valid rejection. In particular, the reference applied by Examiner Azpuru has a publication date which is after the filing date of Applicant's patent application and therefore not more than one year prior to the date of application for patent in the United States, as required by 35 U.S.C. § 102(b). As a result, claims 1-20 are not validly rejected under 35 U.S.C. § 102(b). In a similar manner, the article of Branders.com has a publication date of March 2000, which is after the filing date of Applicant's patent application and therefore similarly not valid prior art.